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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,412	12/03/2003	Wayne L. Poll	3991019-147513	5592
23570 7590 07/24/2007 PORTER WRIGHT MORRIS & ARTHUR, LLP INTELLECTUAL PROPERTY GROUP 41 SOUTH HIGH STREET 28TH FLOOR COLUMBUS, OH 43215			EXAMINER HOUSTON, ELIZABETH	
			ART UNIT 3731	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/726,412

Applicant(s)

POLL, WAYNE L.

Examiner

Elizabeth Houston

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 13, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 13 states "inner core extends past the distal when the basket..." It is unclear whether applicant intends that the inner core extend past the distal end of the basket or the distal end of the sheath.
4. Claim 16 recites the limitation "of the outer core" in line 3. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 23 recites the limitation "the abutment" in lines 1 and 3 and the limitation "the outer core" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1- 10, 12-14, 16-22, and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Clement (USPN 5,197,968).**

3. Regarding claim 1-4, 7-10, 21, 22, and 24-26: Clement discloses a surgical instrument comprising an outer sheath. In this case the outer sheath is collectively comprised of parts 40, 17 and 50 since tubular members 40 and 17 are coupled by threaded members 44 and 14 and the basket 50 is coupled to the end of 17 (see Fig. 2). Therefore the distal end of the outer sheath is located at the distal end of the basket (64). The outer sheath has a proximal and distal end and having a basket (50) sized for entrapping stones and located near the distal end of the outer sheath. The basket transforms between an expanded condition forming a hollow interior for capturing stones and a collapsed condition for delivery and withdrawal. The periphery of the basket has a plurality of spaced apart openings for passage of stones. An inner core (30) longitudinally extends through the outer sheath and into the hollow interior and is longitudinally movable relative to the sheath (see Figs 3 and 4). The outer sheath is the radially outermost component.

4. Regarding the preamble and claims 21, 22: The distal end of the inner core is *capable* of engaging and fragmenting stones (when enough force is applied).

5. Regarding claims 24 and 2: Movement of the inner core relative to the sheath is capable of transforming the basket from an expanded condition to a collapsed condition (when the distal tip (31) of the inner core is pushed against the distal tip (64) of the basket it is capable of forcing the naturally expanded basket to collapse). The inner

Art Unit: 3731

core engages with the outer sheath to apply a tensile force to the outer sheath, which lengthens the outer sheath by collapsing the basket.

6. Regarding claims 3 and 25: The basket is preformed in the expanded condition to resiliently return to the expanded condition from the collapsed condition upon removal of force applied by the inner core (Col 4, line 41-45).

7. Regarding claim 4: An abutment of the inner core (31) is capable of engaging an abutment of the outer sheath (64) to resiliently deform the basket from the expanded condition to the collapsed condition.

8. Regarding claims 7 and 26: Although the inner core has cutting tip (31), it can still be considered a blunt nose for fragmenting stones in that the very distal surface (consider cross section point of view) of the inner core is a blunt nose as compared to a sharpened tip of a needle.

9. Regarding claim 8: The spring (26) or the user is considered to be the energy source connected to the inner core.

10. Regarding claim 9: The energy source is a vibrating device in that the handle and spring are repeatedly actuated by the user (C3: L48 – C4: L12).

11. Regarding claim 10: The energy source can be considered a drilling device in that it would be necessary to provide repeated blows to the stone in order to fragment it with the distal tip of the inner core.

12. Regarding claims 1-3, 5, 6-10, 12-14, and 16-22: Clement discloses a surgical instrument comprising an outer sheath. In this case the outer sheath is collectively

Art Unit: 3731

comprised of parts 40, 17 since tubular members 40 and 17 are coupled by threaded members 44 and 14. The basket 50 is considered a separate member (see Fig. 2).

Therefore the distal end of the outer sheath is located at the distal end of either (40) or (17).

13. Regarding claims 5 and 6: The distal end of the outer sheath (40 and 17) has an opening for the inner core to extend through and the distal end of the inner core is moveable from a retracted position within the basket (Fig. 3 or 4) to an extended position past the distal end of the outer sheath (Figs. 3 and 5).

14. Regarding claims 12 and 20: Longitudinal movement of the inner core (30) relative to the outer sheath (40 and 17) is capable of transforming the basket from an expanded condition to a collapsed condition (when the distal tip (31) of the inner core is pushed relative to the outer sheath and against the distal tip (64) of the basket it is capable of forcing the naturally expanded basket to collapse). The distal end of the inner core is moveable from a retracted position within the basket (Fig. 3 or 4) to an extended position past the distal end of the outer sheath (Figs. 3 and 5) to fragment stones outside the basket (Note Fig. 4 where the stone extends outside the basket).

15. Regarding claim 13: the distal end of the inner core extends past the distal end of the outer sheath when the basket is in the collapsed condition.

16. Regarding claim 16: the distal end of the outer (40 and 17) sheath has an opening for the inner core to extend through.

17. Regarding claims 14, 16, 17, 18 and 19: see claims 3; 5; 21 and 22; 7 and 26; and 8 above respectively.

18. **Claims 1-8, 11, 12, 14 and 16-22 rejected under 35 U.S.C. 102(b) as being anticipated by Avellanet (USPN 6,264,664).**

19. Avellanet discloses a surgical instrument (see entire document, specifically Figure 12) comprising an outer sheath (equivalent of 20, Fig. 1) having a proximal and distal end and having a basket (416) sized for entrapping stones (342) and located near the distal end of the outer sheath. The basket transforms between an expanded condition forming a hollow interior for capturing stones and a collapsed condition for delivery and withdrawal (Col 4:L49-58 and Col 8: L9-25). The periphery of the basket has a plurality of spaced apart openings for passage of stones. An inner core (414 combined with fiber optic cable) longitudinally extends through the outer sheath and into the hollow interior and is longitudinally movable relative to the sheath. The outer sheath is the radially outermost component.

20. Regarding claims 12 and 20: Movement of the inner core relative to the sheath is capable of transforming the basket from an expanded condition to a collapsed condition (C 4:L49-58). The distal end is moveable from a retracted position within the basket (when the basket is retracted into the sheath the distal end of the basket slides distally to surround the distal end of the core) to an extended position past the distal end of the outer sheath to fragment stones outside the basket (Fig. 12).

21. Regarding claim 2: see claims 12 and 20 above.

Art Unit: 3731

22. Regarding claim 3: The basket is preformed in the expanded condition to resiliently return to the expanded condition from the collapsed condition upon removal of force applied by the inner core (C 5:L 60 – C6:L14).

23. Regarding claims 5 and 16: The distal end of the outer sheath (40 and 17) has an opening for the inner core to extend through.

24. Regarding claim 6: see claims 12 and 20 above.

25. Regarding claims 7: The distal end of the inner core (optic fiber) has a blunt nose for fragmenting.

26. Regarding claims 8, 11, and 19: The inner core is connected to an energy source (C 4:L19).

27. Regarding claim 4 (see Fig. 11): The inner core is 392 and the outer sheath is components 320, 314 and 316 combined, since 320 and 314 are coupled at the proximal end. An abutment of the inner core (distal end of 392) engages an abutment of the outer sheath (361) to resiliently deform the basket from the expanded condition to the collapsed condition.

28. Claims 1, 3 and 5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Narayan (USPN 5,176,688).

29. Narayan discloses a surgical instrument (see entire document, specifically Figure 3) comprising an outer sheath (23) having a proximal and distal end and having a basket (16) sized for entrapping stones (24) and located near the distal end of the outer sheath. The basket transforms between an expanded condition forming a hollow interior

Art Unit: 3731

for capturing stones and a collapsed condition for delivery and withdrawal (Col 2:L27-48). The periphery of the basket has a plurality of spaced apart openings for passage of stones. An inner core (31) longitudinally extends through the outer sheath and into the hollow interior and is longitudinally movable relative to the sheath. The outer sheath is the radially outermost component.

30. Regarding claim 3: The basket is preformed in the expanded condition to resiliently return to the expanded condition from the collapsed condition upon removal of force applied by the inner core (C 2:L 37-40).

31. Regarding claims 5: The distal end of the outer sheath has an opening for the inner core to extend through.

32. Regarding claim 6: The inner core is retracted and extended (C4: L10-12).

33. Regarding claims 7: The distal end of the inner core has a blunt nose for fragmenting (C2:L66-67).

34. Regarding claims 8-10: The inner core is connected to an energy source for vibrating and drilling (spring 33, C3:L1-8 and C4:L1-19)).

Allowable Subject Matter

35. Claims 15 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

36. Applicant's arguments with respect to claim have been considered but are moot in view of the new ground(s) of rejection. Regarding the Clement reference, applicant states in the remarks that the device disclosed is much different from the instant invention. However, the claims have not been composed in a way that distinguishes the instant invention from the prior art.

Conclusion

37. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Art Unit: 3731

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Houston whose telephone number is 571-272-7134. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

eh 


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

7/20/07